

REMARKS

The present Amendment and Response pursuant to 37 C.F.R. § 1.111 addresses the issues raised in the initial Office Action mailed on August 11, 2004, in connection with the above-referenced application. Claims 1-20 were originally presented in the application. Applicants note with appreciation the examiner's indication that dependent claim 8 (if combined with the subject matter of independent claim 1) patentably distinguishes over the art of record. Reconsideration of the present application is respectfully requested.

Applicants hereby affirm the provisional election, without traverse, of Species III (Figs. 15, 16, 17 and 18) for examination in the present application. Consistent with the foregoing election, claims 2-4, 7 and 16 have been withdrawn from consideration. Applicants expressly reserve the right to pursue the subject matter of the non-elected subject matter, including the withdrawn claims, in future divisional patent filing(s).

Applicants have amended claims 1, 9 and 12 to effect editorial corrections, as suggested by the examiner. Applicants have also amended independent claims 1, 13 and 20 to further recite patentable aspects of applicants' claimed apparatus/method. Support for the proposed amendments to the independent claims 1, 13 and 20 is found in the specification, as filed (see, e.g., page 16, line 15 to page 17, line 5). In addition, applicants have amended dependent claim 8 so as to ensure consistency with the amended language of independent claim 1. Applicants respectfully submit that no new matter is introduced by way of the present claim amendments and prompt entry thereof is respectfully requested.

With respect to the drawing objections pursuant to 37 C.F.R. §1.83(a), applicants have amended the specification to incorporate numeric designations for structures depicted in amended Fig. 18 (see Replacement Sheet submitted herewith). Applicants respectfully submit

that amended Fig. 18 (and the associated amendments to the specification) obviate the outstanding drawing objections. Reconsideration and withdrawal of such drawing objections are respectfully requested.

Turning to the Section 112 issues raised by the Examiner, applicants respectfully traverse the Examiner's position that the subject matter of claims 11 and 18 would not be enabled (Section 112, first paragraph), and that the subject matter of claims 11 and 18 is indefinite based on "how" and "why" concerns with respect to the recited lighting element. As shown in Fig. 18 (amended), lighting element 280 is advantageously positioned within lower retainer 208. As will be readily apparent to persons skilled in the art from applicants' disclosure, an appropriate power source (e.g., a battery) may be positioned within lower retainer 208, and a switch 282 (e.g., "a piezoelectric or contact switch" as disclosed at page 20, line 21) may control operation of lighting element 280 (e.g., in response to contact between slider 206, shock bushing 210, dampener housing 212 and ultimately lower retainer 208). Applicants' specification and claims are addressed to persons of ordinary skill in the art and such skilled personnel would readily understand from applicants' disclosure that applicants were in possession of the claimed "lighting element" embodiment. Persons of ordinary skill in the art would also conclude that applicants had provided an enabling disclosure for purposes of implementing the disclosed and claimed "lighting element" embodiment. Reconsideration and withdrawal of the Section 112 rejections are respectfully requested.

Turning to the art-based rejections, applicants' claims stand rejected as follows:

- Claims 1, 5, 6, 13, 14, 15 and 17 under 35 U.S.C. §102(b) based on U.S. Patent No. 4,295,832 to Karrell (the "Karrell '832 patent");

- Claims 1, 10 and 13 under 35 U.S.C. §102(b) based on U.S. Patent No. 2,135,648 to Stumpf (the “Stumpf ‘648 patent”);
- Claims 1, 11, 13, 18 and 20 under 35 U.S.C. §102(b) based on U.S. Patent No. 3,677,553 to Moore (the “Moore ‘553 patent”);
- Claims 9, 12 and 19 under 35 U.S.C. §103(a) based on the Stumpf ‘648 patent in view of U.S. Patent No. 2,950,115 to Hurdzan (the “Hurdzan ‘115 patent”);

Each of the cited patents relates to a structure that permits sliding movement of a member along a rod between bounded locations. The Karrell ‘832 patent is directed to an “educational toy,” whereas the Stumpf ‘648 patent, the Moore ‘553 patent, and the Hurdzan ‘115 patent are directed to practice golf clubs. In each of the cited patents, the sliding member(s) are of non-variable design. Stated differently, the prior art patents neither teach nor suggest a swing-related apparatus wherein the slidable member is structured so as to include “an accessible hollow region” that permits weight-adjustment of the slidable member by “introducing or withdrawing material” therefrom. Applicants’ innovative design significantly enhances the utility of the disclosed swing-related apparatus by facilitating variations in the weight of the sliding member. Such variations allow users/teachers to adjust the properties of the swing-related apparatus to address the specific characteristics of the user and his/her swing.

Applicants respectfully submit that amended claims 1 and 13, which recite, *inter alia*, a slidable member defining an accessible hollow region, wherein the weight of said slidable member is adjustable by introducing or withdrawing material from said accessible hollow region, patentably distinguishes over each of the patents relied upon in the outstanding Office Action, whether taken alone or in combination. Similarly, amended independent claim 20 patentably distinguishes over the patents relied upon in the outstanding Office Action (whether taken alone

or in combination) by reciting, *inter alia*, a method that includes (i) providing a slidable member defining an accessible hollow region, and (ii) adjusting the weight of said slidable member by introducing or withdrawing material from said accessible region. Reconsideration and withdrawal of the art-based rejections of independent claims 1, 13 and 20, as amended, are respectfully requested.

Applicants respectfully submit that dependent claims 5, 6, 8-12, 14-15 and 17-19 are patentable over the art of record, whether taken alone or in combination, for at least the reasons noted with respect to independent claims 1 and 13 (from which they depend). Indeed, dependent claim 8 recites patentable subject matter independent of the subject matter of claim 1 from which it depends. For at least the foregoing reasons, reconsideration and withdrawal of the outstanding art-based rejections of applicants' dependent claims are respectfully requested.

Applicants respectfully submit that all claims are now in condition for allowance. Prompt action leading to an early Notice to the effect is earnestly solicited. If the examiner believes a telephone communication might be useful in advancing prosecution of the subject application, the examiner is invited to contact the undersigned representative of the applicant.

Respectfully submitted,

Date: November 12, 2004



Basam E. Nabulsi
Reg. No. 31,645
Attorney for Applicants

McCARTER & ENGLISH, LLP
Four Stamford Plaza
107 Elm Street
Stamford, CT 06902
Phone: (203) 965-0601
Fax: (203) 323-6513

HARTFORD: 626796.01

I hereby certify that this correspondence is being deposited with the United States Postal Service first class mail in an envelope addressed to: Mail Stop New Fee Room, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 11/12/04

(Date of Deposit)

Basam E. Nabulsi
Name of applicant, assignee, or
Registered Representative

Basam E. Nabulsi
Signature

11/12/04
Date of Signature

Amendments to the Drawings

A Replacement Sheet for the drawing sheet that includes Figures 18-21 is enclosed herewith. As set forth on the Replacement Sheet, Figure 18 has been modified to schematically depict subject matter disclosed in applicants' specification, as filed. Support for the proposed drawing modifications is found in the specification, *inter alia*, in the paragraphs commencing at page 16, line 15; page 20, line 18; and page 21, line 5. The foregoing paragraphs are amended herein to include reference numbers corresponding to the structures depicted in amended Figure 18 (i.e., ballast material 225, light 280, switch 282 and sound chip 290). Applicants respectfully submit that no new matter is introduced to the drawings by reason of the proposed drawing amendments, and prompt entry thereof is respectfully requested.